



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,953	02/01/2001	Hiroshi Ono	P/647-137	9136

7590 02/03/2005

STEVEN I WEISBURD
DICKSTEIN SHAPIRIO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS
41ST FLOOR
NEW YORK, NY 10036-2714

EXAMINER

NGUYEN, DUC M

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,953

Applicant(s)

ONO, HIROSHI

Examiner

Duc M. Nguyen

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,9-11,19,20 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,9-11 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 19,20 and 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to applicant's response filed on 12/15/04.

Claims 1, 6, 9-11, 19-20, 22-27 are now pending in the present application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 25-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 25, the claim recites the limitation of "a computer program comprising instructions tailored to the memory, display and output capabilities of said portable terminal", since the specification only describes the "reconstruction capability" in general (particularly to data security such as encryption), the memory, display and output capabilities of the portable terminal contains new subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2685

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19-20, 23-24 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: reconstructing the so formatted content before transferring content not in such format to the external server, and fails to clarify which steps are performed by the external server in claim 19.

As to claim 19, the claim recites the step of "wherein the so formatted content is reconstructed before reconstructing the so converted content data", this explicitly imply that the so converted content data is converted by the external server. However, the claim omits the step of transferring the content not in the format that the telephone can reconstruct to the external server, and also fails to clarify which steps are performed by the external server in claim 19, which also making the claim as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is suggested that the steps as recited in lines 8-11 of claim 19 be removed and be replaced with steps as recited in depend claims 20, 21 in order to overcome the above rejection. Or in an alternative way, the claim be rewritten to clearly identify which content (i.e, received content, formatted content, converted content) and/or which step are processed by the telephone and/or by the external server.

Claim Rejections - 35 USC § 103

Art Unit: 2685

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1, 6, 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shimoda et al (US 6,397,079)** in view of Applicant's admitted prior art (Fig. 14 and pages 1-10), hereafter, AAPA.

Regarding claim **1**, **Shimoda** discloses a radio terminal (cellular phone) with enhanced capabilities through the use of a computer (external server) which is used for converting data into another format such as language translation or encryption functions which may not be feasibly implemented in cellular phones of relatively small size (see Abstract and col. 1, line 55 – col. 3, line 35), this would obviously comprise content acquisition, content transferring and content conversion means as claimed. However, Shimoda fails to disclose the data is acquired from the Internet network. However, such Internet acquisition is well known in the art as disclosed by AAPA (see pages 1-10). Therefore, it would have been obvious to one skill in the art to provide the above teaching of AAPA to Shimoda for downloading encrypt information from Internet as well, thereby providing a data conversion by the computer as claimed, for utilizing advantages of the Internet network such as low cost, global information available in real-time.

As to the limitation regarding the "determination means for determining

Art Unit: 2685

whether the radio terminal can reconstruct the content acquired by the content acquisition means without any conversion", it is noted that if the data does not contain encrypted data, the radio terminal would obviously decode the data without transferring the data to the computer for converting, and would transfer the content to the external server if the data is an encrypted data, thereby result in a determination means as claimed. By doing so, when receiving a data message, the radio terminal would obviously decode the header of the data message to determine whether the data message comprises encrypted information, the decoded header would read on "directly reconstructing in advance at least part of content acquired by the content acquisition means before receiving the converted content from the external server" as claimed. Therefore, it would have been obvious to one skill in the art to modify the above teaching of AAPA to Shimoda for decoding the header of the data message to determine whether the data message comprises encrypted information before transferring the encrypted information to the computer for decrypting, for eliminating unnecessary data transfer.

Regarding claim 6, it is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that when receiving a command from user (voice activated or speech recognition dialing feature), **Shimoda** as modified would disclose the external server request and acquires the content from the Internet in response to the content acquisition request as claimed (see col. 2, line 25-40).

Regarding claim 9, the claim is interpreted and rejected for the same reason as set forth in claim 1 above.

Art Unit: 2685

Regarding claim 10, it is rejected for the same reason as set forth in claim 9 above. In addition, with the broadest reasonable interpretation, the controller or processor the radio terminal in Shimoda's reference would read on the "internal server" as claimed.

Regarding claim 11, the claim is interpreted and rejected for the same reason as set forth in claim 6 above.

Allowable Subject Matter

6. Claims 19-20, 22-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

7. Applicant's arguments filed 12/15/04 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the content comprises two different formats, one is reconstructed by the radio terminal itself while the other format is converted by the external server to the format that can be reconstructed by the radio terminal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments regarding the limitation of

Art Unit: 2685

“determination means for determining whether the radio terminal can reconstruct the content acquired by the content acquisition means without any conversion”, recall that **Shimoda** discloses a cellular phone (read on “radio terminal”) with enhanced capabilities through the use of a computer (read on “external server”), wherein one of the enhanced capabilities includes data **encryption** which may not be feasibly implemented in cellular phones of relatively small size (see Shimoda’s reference, **Abstract** and **col. 1, lines 55-65** and **col. 3, lines 25-35**). Here, since a data encryption is provided by the computer, it is clear that when the cellular phone receives an encrypted data message, the encrypted data would be transferred to the computer for decrypting and transfer back to the cellular phone for utilizations (i.e, display the message in a normal (decrypted) format). Further, it is noted that if the data does not contain encrypted data, the radio terminal would obviously decode the data without transferring the data to the computer for converting, and would transfer the content to the external server if the data is an encrypted data, thereby result in a determination means as claimed. By doing so, when receiving a data message, the radio terminal would obviously decode the header of the data message to determine whether the data message comprises encrypted information, the decoded header would read on “directly reconstructing in advance at least part of content acquired by the content acquisition means before receiving the converted content from the external server” as claimed. Therefore, it would have been obvious to one skill in the art to modify the above teaching of AAPA to Shimoda for decoding the header of the data message to determine whether the data message comprises

Art Unit: 2685

encrypted information before transferring the encrypted information to the computer for decrypting, for eliminating unnecessary data transfer.

Therefore, Applicant argues that **Shimoda** neither taught nor suggested the limitations of “determination means for determining whether the radio terminal can reconstruct the content acquired by the content acquisition means without any conversion”, and “directly reconstructing at least part of content acquired by the content acquisition means before receiving the converted content from the external server” is not persuasive.

For foregoing reasons, the examiner believes that the pending claims are not allowable over the cited prior art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thompson et al (US Pat No. 6,529,743), Universal wireless telephone to modem adapter.

9. **Any response to this action should be mailed to:**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to:

703-872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label PROPOSED or

Art Unit: 2685

DRAFT)

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from
the examiner should be directed to Duc M. Nguyen whose telephone number is
703-306-4531. The examiner can normally be reached on Monday-Thursday
(9:30 AM – 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax
phone number for the organization where this application or proceeding is
assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
703-305-3900.

A handwritten signature in black ink, appearing to read 'Duc M. Nguyen', with a long horizontal flourish extending to the right.

Duc M. Nguyen
Jan 31, 2005